

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 12477-016001
CERTIFICATE OF MAILING BY EFS-WEB FILING I hereby certify that this paper was filed with the United States Patent and Trademark Office using the EFS --WEB system on this date: March 5, 2007	Application Number 10/809,286	Filed March 25, 2004
	First Named Inventor Chad Nelson et al.	
	Art Unit 3749	Examiner Gregory A. Wilson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.


I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record 57,867
(Reg. No.)

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34



 Signature

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 Typed or printed name

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 Telephone number

 March 5, 2007
 Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below'.

☒ Total of 2 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Chad Nelson et al. Art Unit : 3749
Serial No. : 10/809,286 Examiner : Gregory A. Wilson
Filed : March 25, 2004 Conf. No. : 6038
Title : AIR RETURN BULKHEAD WITH QUICK RELEASE MOUNTING SYSTEM

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to the Pre-Appeal Brief Conference Program, a request for a review is hereby submitted with the Notice of Appeal because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

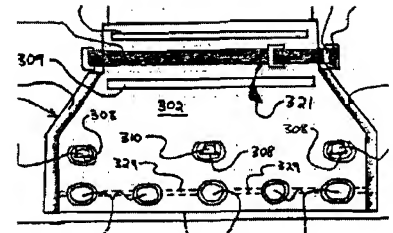
Applicants specifically request the panel to review the issues numbered 1-4 below. Applicants expressly reserve the right to expand these issues and/or present new issues when filing the appeal brief.

1. Henning fails to disclose all elements of claim 21, and the Office Action's rationale of "within the level of ordinary skill in the art" is a poor attempt to fill in the missing elements.

Independent claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Henning (US 5,947,812). The Final Office Action failed to present a *prima facie* case of obviousness by showing that all of the claimed elements existed in the prior art. Instead, the Final Office Action asserted that further modifications would be "within the level of ordinary skill in the art" in a poor attempt to fill in the multiple claim elements that were not found in Henning or in any other prior art of record. The MPEP clearly holds that this conduct fails to satisfy the Examiner's initial burden. MPEP § 2143.01(IV) ("A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' . . . *is not sufficient* to establish a *prima facie* case of obviousness." (emphasis added)).

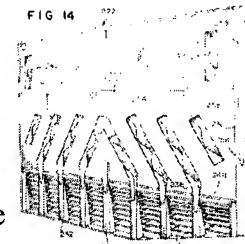
First, unlike claim 21, Henning fails to disclose or suggest "a lower panel portion that is wider than an upper panel portion such that the width of the plenum is greater proximal to the lower panel portion than the width of the plenum proximal to the upper panel portion." One

example of this claimed feature is shown in Applicant's FIG. 3 (shown at right). Quite the opposite, Henning describes a bulkhead having a "rectangular" panel, as shown in Henning's FIG. 14 at below-right. (See Henning at col. 1, line 65; col. 3, lines 38-39; at col. 4, line 39.)



The Office Action contends that Henning could be modified to have the claimed configuration because "such a modification would have involved a mere change in the size/shape of the component *which is generally recognized as being within the level of ordinary skill in the art.*"

(See Office Action at p. 3 (emphasis added).) This poor attempt to fill in the missing elements is not enough. According to the MPEP, such reasoning is insufficient to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. See MPEP § 2143.01(IV) (describing that the rationale of modifications being "well within the ordinary skill of the art at the time the claimed invention was made' . . . *is not sufficient* to establish a *prima facie* case of obviousness." (emphasis added)). Simply put, Henning does not teach all the claim elements, and the Office Action's conclusory statement is inadequate to fill in the blanks.¹ For this reason alone, the rejection of claim 21 must be withdrawn.



Henning's bulkhead 222 is "generally rectangular."

Applicant notes that the Advisory Action dated February 15, 2007 attempts to rely upon a completely new line of reasoning, in which "the internal structure of the bulkhead" meets the claimed shape. Such an assertion of new reasoning for rejection is improper for an Advisory Action, and must only be submitted in a non-final Office Action so that "the applicant can be given fair opportunity to reply." MPEP § 706.02(j). Nevertheless, this new reasoning does not satisfy the Examiner's initial burden. Henning fails to teach the claimed wider lower panel portion, and the Office Action points to nothing in the prior art to suggest the desirability of modifying Henning's panel (as required by MPEP §§ 2143.01(III)).

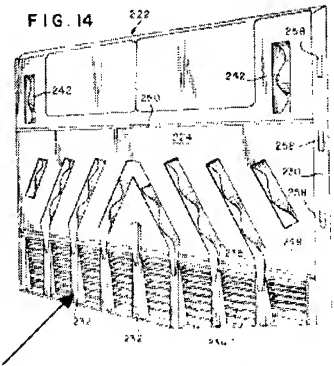
¹ The only attempt to support the conclusory statement in the Office Action was "the applicant has not disclosed that having a bulkhead of this particular shape solves any stated problem or is for any particular purpose that is unobvious to one having ordinary skill in the art." (See Office Action at page 3.) This statement erroneously attempts to place the Examiner's initial burden on the Applicants. The Applicants do not bear an initial burden of explaining why the claimed invention is superior to the prior art. *In re Slocombe*, 510 F.2d 1398 (CCPA 1975) ("There is no requirement that superiority over prior art be disclosed in the application."). Rather, it is the Examiner that bears the initial burden of showing that "the prior art [] suggests the desirability of the combination." MPEP § 2143.01(III); see also MPEP § 706.02(j). This burden clearly was not met.

Second, unlike claim 21, Henning fails to disclose or suggest “means for releasably securing . . . *such that the bulkhead is secured to the wall in an elevated position above a floor of the trailer.*” The Final Office Action conceded that Henning fails to disclose this element, but instead contended that Henning’s bulkhead 222 is “capable of securing” in an elevated position and one would be motivated to do so because “a larger airflow is [] provided.” As described in Applicant’s Response dated January 30, 2007, this “larger airflow” reasoning is mistaken. The subsequent Advisory Action apparently acquiesced, and then provided a new reasoning not based on the “larger airflow” and instead based upon “inherent capabilities.” Again, such an assertion of new reasoning for rejection must be submitted in a non-final Office Action so that “the applicant can be given fair opportunity to reply.” MPEP § 706.02(j). Nevertheless, this new reasoning fails. The Advisory Action stated that “anything capable of securing is inherently capable of being ‘releasably secured.’” This unsupported conclusion, of course, completely ignores that claim 21 does not recite any possible type of releasable securement, but further requires that “the bulkhead is secured to the wall in an elevated position above a floor of the trailer.” In short, Henning does not disclose the claimed means for releasably securing, and for this reason alone, the rejection must be withdrawn.

2. The proposed combination of Henning and Manfred fails to disclose all elements of claim 23, and the Office Action’s “mere reversal of the essential working parts” rationale simply does not satisfy the Examiner’s initial burden.

Independent claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Henning in view of Manfred (EP 1099598A2). Again, the Final Office Action failed to present a *prima facie* case of obviousness by showing that all of the claimed elements existed in the prior art. Instead, the Final Office Action relied upon the rationale of “mere reversal of the essential working parts” in an attempt to fill in the claim elements that were not found in the proposed combination of Henning and Manfred. This reasoning merely reflects an incomplete reading of the claim language, and does not satisfy the Examiner’s initial burden.

First, as previously described in connection with claim 21, Henning fails to disclose or suggest “means for releasably securing . . . *such that the bulkhead is secured to the wall in an*



Henning's tapered sections 232 serves as "pallet stops," which rest on the trailer floor to receive impacts from cargo pallets being loaded into the trailer. (See, e.g., Henning at FIGS. 5 and 14; col. 3, line 65-67.)

elevated position above a floor of the trailer.” Manfred is also lacking a disclosure of this element or a suggestion to modify Henning’s bulkhead. For this reason alone, Applicants request withdrawal of the rejection under 35 U.S.C. § 103.

Second, the Office Action concedes Henning fails to describe the claimed hook members as described in claim 23. The Manfred reference is also lacking. Unlike claim 23, Manfred fails to describe hook members that “extend in an *angularly upward direction from the trailer wall.*” Instead, Manfred teaches that neighboring panels (5) are fitted with downwardly extending hooks 3 and 4 that rest on horizontal crossbars (6, 7) fitted between the side walls of a cargo container. (See Manfred, Abstract and FIGS. 1, 2a, and 2c.) Thus, the proposed combination of Henning’s bulkhead 222 with Manfred’s hooks 3 and 4 would result in a bulkhead 222 that is mounted to horizontal crossbars extending between the trailer sidewalls. For this reason alone, the rejection of claim 23 must be withdrawn.

Third, unlike claim 23, Manfred’s hooks 3 and 4 do not engage the crossbars so that a portion of the panel “*is increasing compelled toward the trailer wall as hook members engage the panel.*” The Office Action provided no explanation as to how Manfred’s hooks 3 and 4 would compel the panels 5 toward a trailer wall—the particular wall that is used to at least partially define a plenum (as described in claim 23). This is because Manfred’s hooks 3 and 4 merely rest on the crossbars 6 and 7. In short, no combination of Henning’s bulkhead 22 and Manfred’s hooks 3 and 4 would result in the claim elements set forth in claim 23. For this reason alone, the rejection of claim 23 must be withdrawn.

The Final Office Action erroneously brushed aside these claim elements that are not disclosed by Manfred by stating that “it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art.” (See Office Action at page 4.) Again, unsupported conclusory assertions are inadequate to fulfill the Examiner’s initial burden under MPEP § 2143. First, if a rule “has been held” to operate against the Applicants here, the Office Action should in the very least provide an authoritative citation in support of this rule and

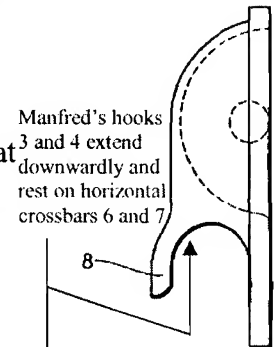


Fig. 2c

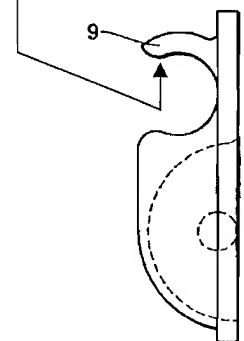


Fig. 2a

an explanation of how the authoritative citation applies to this case. No such citation was provided. Second, the subject matter described in claim 23 is not a "mere reversal of the essential working parts." As previously described, Manfred's hooks are attached to the panels 5 (not the trailer wall) and extend downwardly to rest on the horizontal crossbars (e.g., no teaching or suggestions that the hooks compel the panels 5 toward the trailer wall).²

3. The Henning reference fails to disclose all elements of claim 24.


Independent claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Henning alone. Again, the Final Office Action failed to show that all of the claimed elements existed in the prior art. For reasons similar to those described in connection with claim 21, Henning fails to disclose "***a lower panel portion that is wider than an upper panel portion such that the width of the plenum is greater proximal to the lower panel portion than the width of the plenum proximal to the upper panel portion.***" Also, Henning fails to disclose "a plurality of mounting members to releasably secure the peripheral portion in abutment with the wall ***such that the bulkhead is secured to the wall in an elevated position above floor of the trailer.***" For any of these reasons, the rejection of claim 24 must be withdrawn.

4. The proposed combination of Henning and Manfred fails to disclose all elements of claim 26.

Independent claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Henning in view of Manfred. Again, the Final Office Action failed to show that all of the claimed elements existed in the prior art. For reasons similar to those described in connection with claim 23, Henning and Manfred both fail to disclose or suggest "a plurality of mounting members to releasably secure the peripheral portion in abutment with the wall ***such that the bulkhead is secured to the wall in an elevated position above floor of the trailer.***" Second, as previously described, Manfred fails to describe hook members that "extend in ***an angularly upward direction from the trailer wall.***" Thus, the rejection of claim 26 must be withdrawn.

Respectfully submitted,

Date: March 5, 2007



Michael T. Hawkins

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² Applicants note that these arguments were presented in the Response dated January 30, 2007, but the subsequent Advisory Action failed to address these issues related to claim 23. Indeed, the Advisory Action did not address the failures of the Manfred reference in any aspect.